



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/747,612

12/30/2003

Phillip Ace McCoppin

201818-0307164

2890

909

7590

02/06/2009

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

BAIRD, EDWARD J

ART UNIT

PAPER NUMBER

3695

MAIL DATE

DELIVERY MODE

02/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/747,612	Applicant(s) MCCOPPIN ET AL.	
	Examiner Ed Baird	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1– 3, 7, 11 – 12, 14– 15, 19, and 23 – 24. No new claims have been added or canceled. Thus, claims 1 – 24 remain pending and are presented for examination.

Response to Arguments

2. Applicant's remarks/ arguments filed 13 November 2008 have been fully considered.

3. Examiner acknowledges amendments to claims 2, 3, 7, 11, 12, 14, 15, 19, and 23 – 24 to overcome 35 U.S.C. § 112, 2nd paragraph rejections and, in turn, withdraws rejection.

4. Applicant's arguments filed with respect to claims 1 – 3, 5 – 15 and 17 – 24 regarding the 35 U.S.C. § 102(e) rejections and arguments filed with respect to claims 4 and 16 regarding the 35 U.S.C. § 103(a) rejections have been fully considered but they are not persuasive.

5. Applicant argues that an “insured bank” as set forth by the Examiner corresponds to a bank whose investor's cash deposits are protected by Federal Deposit Insurance Corporation (FDIC) insurance [Remarks page 9, 2nd paragraph]. Further, Applicant argues Lawrence does not address “guaranteed funding” of a financial transfer of funds, as specifically claimed by Applicant [Remarks page 11, 2nd paragraph]. However, Examiner respectfully disagrees.

6. As per independent claims 1 and 13, “any insured bank” as disclosed by **Lawrence** is analogous to Applicant's "system that provides guaranteed funding of the transaction". The claimed invention of the instant application does not make a distinction as to how funding is guaranteed. Thus, based on the broadest reasonable interpretation, an “insured bank” is one that guarantees funding as claimed by the Applicant in claims 1 and 13. Accordingly, Examiner maintains 102(e) and 103(a) rejections.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 – 3, 5 – 15, and 17 – 24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lawrence** (US Pub. No. 2003/0233319).

9. Regarding **claims 1 and 13**, **Lawrence** teaches:

- Receiving, **in a computer processor**, financial transaction payment instructions from a Client Bank **over a computer network** [see at least 0065 and Figure 2] in a format associated with a settlement funds transfer system that provides guaranteed funding of the transaction to a Receiver Financial Institution [see at least Abstract, 0022 – 0024, and Figure 1]. Examiner interprets financial institution as including Applicant's Client Bank and Receiver Financial Institution. Examiner notes that these financial institutions include "*any insured bank*"; thus "*any insured bank*" is analogous to Applicant's **providing guaranteed funding of transactions**.
- analyzing **by the computer processor**, the received financial transaction payment instructions [see at least 0030, 0032 and 0057]. Examiner interprets a *risk management clearing house (RMC)* which "gathers data, ... and relates the data to risk variables for the purpose of managing risk associated with a risk variable" as analogous to Applicant's analyzing **payment instructions**.

Art Unit: 3695

- generating **in a computer processor**, foreign financial transaction payment instructions for at least one financial institution located in a foreign country, **and transmitting the payment instructions over the computer network** [see at least 0078 and Figure 5],

the foreign financial transaction payment instructions including data in a funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution [see at least 0031 and 0033]. Examiner notes that *financial institutions* [0024] include foreign banks and foreign financial agencies.

10. Regarding **claims 2 and 14, Lawrence** teaches:

- wherein the settlement funds transfer system comprises a U.S. Federal Reserve Bank funds transfer system that carries out domestic funds transfers [see at least 0029],
- wherein the financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt [see at least 0041 and 0042].

11. Regarding **claims 3 and 15, Lawrence** teaches:

- wherein the funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution is compatible with a world-wide financial messaging network **interfaced with the computer network** comprising standardized messaging services and interface software **running in a computer processor that initiates** international payments [see at least 0002, 0023, and 0029]. Examiner notes that SWIFT (“Society for Worldwide Interbank Financial Telecommunication”) is an example of Applicant's **world-wide financial messaging network**.

Art Unit: 3695

12. Regarding **claims 5 and 17**, **Lawrence** teaches the Client Bank as a domestic bank [0024].
13. Regarding **claims 6 and 18**, **Lawrence** teaches the financial transaction is self funding [see at least 0023 and 0024].
14. Regarding **claims 7 and 19**, **Lawrence** teaches:
 - the financial transaction payment instructions are received via a **network** interface with the settlement funds transfer system, said **network** interface being configured to provide access to a U.S. Federal Reserve Bank funds transfer system useful for carrying out domestic funds transfers [see at least 0024].
15. Regarding **claims 8 and 20**, **Lawrence** teaches:
 - transmitting the foreign financial transaction payment instructions to the at least one financial institution [see at least 0024].
16. Regarding **claims 9 and 21**, **Lawrence** teaches:
 - the at least one financial institution includes a branch of the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions [see at least 0026 and 0027].
17. Regarding **claims 10 and 22**, **Lawrence** teaches:
 - the at least one financial institution includes a member of a non-Federal Reserve Bank electronic payments system [see at least 0024].
18. Regarding **claims 11 and 23**, **Lawrence** teaches:
 - the at least one financial institution includes a member of a U.S. Federal Reserve Bank funds transfer system **that carries** out domestic funds transfers [see at least 0023],

Art Unit: 3695

- wherein the financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt thereof receipt [see at least 0041 and 0042].

19. Regarding **claims 12 and 24, Lawrence** teaches:

- the at least one financial institution includes a correspondent bank that is connected to the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions via a world-wide financial messaging network [see at least 0023 and 0029]
- **the world-wide financial messaging network** comprises standardized messaging services and interface software (running in at least one processor that initiates—claim 24) **used to initiate** international payments [see at least 0067 – 0069],
- the correspondent bank handling business in a particular geographic area [see at least 0002, 0051 and 0059].

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence** in view of **SWIFT.com** (“MT 103 migration – a success for the whole community”, home page stories archive 2003, posted 11/21/2003).

22. Regarding **claims 4 and 16, Lawrence** teaches all the items of claims 2 and 14, the claims upon which these claims depend, respectively, but do not teach foreign financial

Art Unit: 3695

transaction payment instructions which comply with SWIFT MT 103 specifications (i.e. messaging standards).

However, **SWIFT.com** teaches about foreign financial transaction payment instructions which comply with SWIFT MT 103 messaging standards. **SWIFT.com** discloses “The weekend of 15-16 November saw two significant events in SWIFT’s history. The first was the removal of the MT 100, SWIFT’s most-used message, from the network. To enable this to happen, migration to the MT 103 needed a successful completion and this was achieved with a 98% migration rate on the last working day before the deadline”, [2nd paragraph].

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Lawrence’s** disclosure to include *SWIFT MT 103 specifications* as disclosed by **SWIFT.com** because its use would increase certainty, transparency, and automation (STP) of customer transfers as well as reduced cost, reduced risk, and conform to worldwide regulatory requirements.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3695

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Baird whose telephone number is (571)270-3330. The examiner can normally be reached on Monday - Thursday 7:30 am - 5:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ed Baird/
Examiner, Art Unit 3695

/Narayanswamy Subramanian/
Primary Examiner, Art Unit 3695